

REMARKS

Claims 1-3 and 5-21 are currently pending in the application. Independent claim 13 has been amended herein.

Claim 13 stands rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant has amended claim 13 as suggested by the Examiner to overcome this rejection.

Claims 2-3, 5-9, and 11-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,175,963 (Loeffelholz) in view of U.S. Patent No. 6,370,696 (Kronenberger). **As an initial matter, claim 1 was again not specifically rejected in the Office Action. Applicant again requests clarification regarding claim 1.**

Applicant notes that the contents of the "information" must not be ignored and must be considered in determining patentability. The Federal Circuit *In re Gulack* 217 USPQ 401 (Fed. Cir. 1983) stated that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter" (at page 403).

The Court stated further that "[u]nder Section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole" (at page 403).

Furthermore, the present case is similar to *In re Miller*, 418 F.2d 1392, 153 U.S.P.Q. 46 (C.C.P.A. 1969) and *In re Gulack* as opposed to *In re Seid*. The Examiner has

indicated that he fails to find a similar relationship in the present case as was found in both *In re Miller* and *In re Gulack*. Applicant disagrees with the Examiner's position and has included additional details which support the significant similarities between the present application and *In re Miller* and *In re Gulack* which cannot be ignored.

*In re Miller* concerned a measuring device having information printed on the device to educate an observer as to quantities when making fractional recipes without having to actually compute the fractional quantity necessary. The Patent Office initially rejected the claims as it did not see a structural relationship between the information and the device. The Federal Circuit reversed the Patent Office rejection stating that there was a new and nonobvious functional relationship between the information and the substrate. The Federal Circuit found that there was a new and non-obvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating a volume in a certain ratio to the actual volume and a legend indicating the ratio.

Just as in *In re Miller*, the first and second information has a new and nonobvious functional relationship with the substrate, the cap. The cap, the second information and the first information are analogous to the receptacle, indicia and legend as in *In re Miller*. The cap is clearly analogous to the receptacle in *In re Miller* as both structures are used as substrates for information. The second information is analogous to the indicia because just as the indicia indicates the use of the receptacle (½ cup, 1/3 cup, etc.), the second information indicates the use of the cap (such as which participants or teams use the cap). Additionally, the first information is analogous to the legend because just as the legend indicates the ratio of the receptacle which a user can use to associate the receptacle size

with the indicia, the first information indicates an event which a user can use to associate the cap with the first information (participants, teams, etc). Therefore, contrary to the Examiner's position, the present case shares the same functional relationship as was found in *In re Miller*. None of the cited references discloses such a functional relationship and therefore the information, as well as the recited location of the information, which must be given patentable weight, distinguish over the cited art.

Moreover, in *In re Miller*, the Examiner did consider the indicia and legend as proper parts of the structure and having a definite structural relationship when they were required to be in a specific location. 418 F.2d at 1395. The claims reciting a specific location for this information were allowed by the Examiner without intervention from the Federal Circuit. The present case is identical to these "allowed" claims in *In re Miller*, as the first and second information are recited at specific locations as outlined in the claims. Therefore, for this additional reason, the information, as well as the recited location of the information, must be given patentable weight.

Furthermore, *In re Gulack* continued the holding in *In re Miller* and concerned an educational and mathematical device wherein a series of numbers were placed on a circular band that could be placed upon a hatband or other article of apparel. The information related to numbers, multiplication tables and other information to be displayed to an observer. The Federal Circuit found that there was a new and non-obvious functional relationship between the band, the digits imprinted on the band and the algorithm by which the digits were developed.

The present invention is similar to *In re Gulack* because, just as in *Gulack*, the first and second information is functionally related to the cap (band). The cap is analogous to

the band in *In re Gulack* as both structures are used as substrates for information. The first and second information is analogous to the digits because just as the digits are a unique combination of information associated by an algorithm used to educate a user as to the relationship between numbers (a mathematical problem), the first and second information are associated to one another to educate a user as to the relationship between an event and the specific participants in the event. Furthermore, in the present case, the information is recited as being in specific locations on the cap. Therefore, the information, as well as the recited location of the information, must be given patentable weight.

In view of the above, the rejection is improper and should be withdrawn as the Office Action has not given full meaning to the recited language in the claims. Specifically, independent claim 1, from which all remaining claims depend, recites "first information identifying an event on at least one of the front/left side and front/right side octants; and second information identifying a plurality of participants in the event on at least one of [six recited octants]." This structure is simply not disclosed or suggested in the cited references.

The Examiner correctly acknowledges that Loeffelholz does not disclose a front right or left side identifying an event or showing a plurality of participants. To overcome this deficiency, the Examiner attempts to combine Loeffelholz with Kronenberger. The Examiner alleges that Kronenberger discloses designs that include schools, objects, information, etc. around the cap. However, this alleged disclosure is not what is recited in claim 1 which requires first and second information each having specifically claimed locations on the cap. Therefore, the cited references, taken alone or in combination, fail

to disclose the recited first information and second information and the locations specified in claim 1.

To overcome this further deficiency, the Examiner states on page 4 of the Office Action, "it is the opinion of the examiner that the information claimed, provides no structure to the cap that is not shown in the prior art are mere design choices", which indicates that the Office Action has not given patentable weight to the specific information or locations recited. The Office Action continues, relying on *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947) to indicate that matters relating to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art. Applicant agrees that ornamentation alone cannot be used in a utility patent to distinguish the prior art. However, *In re Seid* is distinguishable from the present case. *In re Seid* concerns a bottle arranged to give the impression of the human body. The applicant in that case attempted to distinguish over prior art based upon the ornamental appearance of the bottle. Conversely, Applicant in the present case is relying upon the function of the first and second information, as well as the specific locations of the respective information to educate an observer of the cap as to the contents of the information as opposed to simply providing ornamentation. The resultant ornamental appearance of the information is simply a secondary result of the appearance of the information on the cap.

For example, the first information might include the event such as a playoff game or an all star game. The second information might relate to participants in that event. By reason of its location, the first information, pertaining to the event, is viewable from the front of the headwear piece, whereas the second information is not clearly viewable from the same perspective. Those viewing the headwear piece from the front thereof will be

apprised of the identification of the event. As the viewing perspective changes, the information relating to the participants can be clearly focused upon. From the front, the information is strategically located so as to highlight the event, while at the same time, the headwear bears information pertaining to the participants. This information as well as the recited locations must be given patentable weight.

The location is especially significant in the present invention as it turns the headwear piece into a multi-functional structure. For example, the headwear piece can be worn by a player, such as for pictures used during the game when the player is at bat, and the information located on the at least one of the front/left side and front/right side octants is seen in the picture highlighting such information as the event or player's team affiliation. Therefore, the headwear piece serves the function of a traditional headwear piece worn before, during and after a game by a player. The second information identifies a plurality of participants in the event which may not be required to be seen in the pictures used during the game when the player is at bat. Therefore, the second information may or may not be visible when the headwear piece is viewed from the front. However, souvenir collectors and fans alike often desire souvenirs which contain all of the participants from the game as well as souvenirs that are identical to the headwear pieces worn by the players. The recited headwear piece performs both of these functions as the piece is a souvenir as well as the same hat worn by the players. Therefore, the location of the information on the claimed multi-functional headwear piece must be given patentable weight.

Claims 2-3, 5-9, and 11-18 depend cognately from claim 1 and recite further significant structural detail to further distinguish over the combination of Loeffelholz and

Kronenberger. Furthermore, patentable weight must be given to the features recited therein as the information, as well as the location of the information, has a functional relationship with the cap, which cannot be ignored. For example, claim 2 recites that the second information can be seen but is not identifiable when viewing the headwear piece from a front elevation perspective, whereas claim 3 recites that the second information cannot be seen from a front elevational perspective. As discussed *supra*, the location of the information must be given patentable weight. The location of the information, as well as the ability to view and identify the information resulting therefrom, must be given patentable weight.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 6,408,443 (Park). Park adds nothing regarding the above-noted shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fail to disclose or suggest the features recited in independent claim 1, the rejection of dependent claim 10 is improper and should be withdrawn.

Claims 19-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 5,584,076 (Armstrong). Claims 19-21 are directed to an adjustable strap, and in the case of claims 20 and 21, information thereon. Claims 21 specifically characterizes the information as identifying the event, as does the first information recited in claim 1.

While Armstrong discloses information on an adjustable strap, the information is not described as being correlated with any corresponding first and second information, as with an event, as claimed. Additionally, Armstrong adds nothing regarding the above-noted

shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fails to disclose or suggest the features recited in independent claim 1, the rejection of dependent claims 19-21 is improper and should be withdrawn.

**Clarification of the status of claim 1**, entry of the amendment, reconsideration of the rejection of claims 2,3 and 5-21 and allowance of the case are requested.

Respectfully submitted,

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